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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,949	04/05/2004	Michael Rooke	060091.00284	2406
32294 7590 12/30/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER				
I.Y. NGHH H				
ART UNIT		PAPER NUMBER		
2617				
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12/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,949

Applicant(s)

ROOKE ET AL.

Examiner

NGHI H. LY

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-21, 23-34, 36, 45-47, 49-66 and 70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-21, 23-34, 36, 45-47, 49-66 and 70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 2, 5-9, 11-20, 23-27, 29-34, 36, 45, 46, 49-53, 55-66 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fenton et al (2003/0193967A1) in view of Yamaguchi (US 6,871,065).

Regarding claims 1, 19, 45, 60, 65, 66 and 70, Fenton teaches a system (see fig.1), the arrangement comprising: a first system entity configured to provide a multimedia messaging service to user equipment connected to a network of a system

(see Abstract and fig.1), and a second system entity configured to provide a value added service (see [0031]) to a user of the user equipment via the multimedia messaging service (see Abstract, [0007], [0008], [0028], [0036], [0038], [0041], [0070], [0075], [0080], [0086] and [0104]), wherein the first system entity is configured to send a message to the second system entity (see Abstract, [0007], [0008], [0028], [0036], [0038], [0041], [0070], [0075], [0080], [0086] and [0104]), the message comprises roaming information about the user equipment (see [0039] and [0133]).

Fenton does not specifically disclose the second system entity is configured to use the roaming information when providing the value added service to the user equipment.

Yamaguchi teaches the second system entity is configured to use the roaming information when providing the value added service to the user equipment (see column 8, lines 60-65, also see Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Yamaguchi into the system of Fenton in order to provide the mobile communication system suitable to provide contents to the mobile communication terminal which moves in a wide area, and a mobile communication method and a mobile communication program used in the mobile communication system (see Yamaguchi, column 1, lines 10-15).

Regarding claims 2, 20, 46 and 56, Fenton further teaches the roaming information comprises a roaming status configured to indicate whether the user

equipment is roaming outside a home network of the user equipment (see [0039] and [0133]).

Regarding claims 5, 23 and 49, Fenton further teaches the second system entity is configured to adapt, based on the roaming information (see [0039] and [0133]).

Regarding claims 6, 24, 50, 61 and 63, Fenton teaches the second system entity is configured to encrypt or decrypt at least part of the content of the at least one multimedia message to be delivered to the user equipment according to the roaming information (see [0036]).

Regarding claims 7, 25, 51, 62 and 64, Fenton teaches the second system entity is configured to use digital rights management to perform the encryption or decryption by using digital rights management (see [0036]).

Regarding claims 8, 26 and 52, Fenton further teaches the second system entity is configured to determine, based on the roaming information, whether the value added service is providable to the user equipment (see [0039] and [0133]).

Regarding claims 9 and 53, Fenton further teaches the second system entity is configured to select a route or a destination of at least one multimedia message to be delivered to the user of the user equipment according to the roaming information (see Abstract, [0007] and [0008]).

Regarding claims 11, 29 and 55, Fenton further teaches the second system entity is configured to determine charging related information according to the roaming information and to add the charging related information to at least one multimedia message to be delivered to the user equipment (see [0039] and [0133]).

Regarding claims 12 and 30, Fenton further teaches the first system entity is configured to send the message comprising the roaming information about the user equipment to the second system entity in response to a request received from the second system entity (see [0007], [0008], [0028] and [0041]).

Regarding claims 13 and 31, Fenton further teaches the first system entity is configured to obtain information about a location of the user equipment from another system entity and to determine the roaming information on the user equipment according to the obtained location information before sending the message comprising the roaming information about the user equipment to the second system entity (see [0031] and [0133]).

Regarding claims 14, 15, 32, 33, 57 and 58, Fenton further teaches the message comprising the roaming information about the user equipment is an multimedia message interface message (see [0007], [0008], [0041], [0075] and [0080]).

Regarding claims 16 and 34, Fenton further teaches the first system entity comprises a multimedia messaging service center (see [0008], [0041], [0086] and [0104]).

Regarding claims 17 and 59, Fenton further teaches the second system entity comprises a multimedia messaging service value added service application (see Abstract, [0008], [0075], [0080] and [0086]).

Regarding claims 18 and 36, Fenton further teaches the user equipment comprises a mobile station (see fig.1).

Regarding claims 27, Fenton further teaches selecting (see Abstract, [0008], [0075], [0080] and [0086]), a route or a destination of at least one multimedia message to be delivered to a user of the user equipment according to the roaming information (see [0031] and [0133]).

4. Claims 3, 10, 21, 28, 47 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fenton et al (2003/0193967A1) in view of Yamaguchi (US 6,871,065) and further in view of Elizondo (US 6,917,813).

Regarding claims 3, 21 and 47, the combination of Fenton and Yamaguchi teaches claims 1, 19, 45, 60, 65, 66 and 70. The combination of Fenton and Yamaguchi does not specifically disclose the roaming information comprises an address of a switching centre which the user equipment is using.

Elizondo teaches the roaming information comprises an address of a switching centre which the user equipment is using (see column 2, lines 18-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Elizondo into the system of Fenton and Yamaguchi in order to provide SMS service when different SS7 signaling networks are in use (see [0012]).

Regarding claims 10, 28 and 54, Fenton further teaches the second system entity is configured to determine a location of the user equipment according to the address of the switching center that the user equipment is using and provide the user

equipment with information relating to the determined location (see [0032], [0039], and [0079]).

Response to Arguments

5. Applicant's arguments with respect to claims 1-3, 5-21, 23-34, 36, 45-47, 49-66 and 70 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571)272-7911. The examiner can normally be reached on 9:30am-8:00pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly

/Nghi H. Ly/

Primary Examiner, Art Unit 2617